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REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed August 27, 2004. In the Office Action, the Examiner notes that claims 1-84 are pending and rejected. By this amendment, Applicant has cancelled claims 22-26, 50-54, and 78-82, and claims 1-21, 77-49, 55-77, and 83-84 continue unamended.

In view of both the amendments presented above and the following discussion, Applicant submits that all of the claims now pending in the application are obvious under 35 U.S.C. §103. Thus, Applicant believes that all of these claims are now in allowable form.

REJECTIONS

35 U.S.C. §103

Claims 1-84

The Examiner has rejected claims 1-84 as being obvious and unpatentable under the provisions of 35 U.S.C. §103(a). In particular, the Examiner has rejected claims 1-84 as being unpatentable over U.S. Patent 6,553,178-B2 to Abecassis (hereinafter "Abecassis") in view of U.S. Patent 5,754,938 to Herz (hereinafter "Herz"). Applicant respectfully traverses the rejection.

A. Claims 22-26, 50-54, and 78-82

The Applicant has cancelled claims 22-26, 50-54, and 78-82. Therefore the rejection is now deemed moot.

B. Claims 1-21, 29-49, and 57-77

Applicant's independent claim 1 (and similarly, independent claims 29 and 57) recites:

- "1. A method for automatically pausing a video program in response to an occurrence of an event, comprising:
receiving a video program;
outputting the video program for presentation on a display device;
detecting occurrence of an audio communications event during the video program presentation;

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pausing the video program in response to the detection of the occurrence of the audio communications event;
converting an audio portion of the audio communications event to corresponding text for display; and
outputting a signal for displaying an indication of the occurrence of the audio communication event." (emphasis added).

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Abecassis and Herz references singly or in combination fail to teach or suggest the Applicant's invention as a whole.

The Abecassis reference discloses an advertisement subsidized video-on-demand system in which, in relevant part, the user of the system may accept a communication during the use of the system and, in response to the acceptance of such communication, cause a video server transmission to be paused. Specifically, the Abecassis reference (see, e.g., FIG. 13, reference 1311 and column 52, lines 18 et seq.) discloses an "acceptance" procedure that is invoked in response to a received communication, wherein a user must affirm an acceptance of the received communication within a prescribed period of time. Only after "acceptance" is there any pausing of content. By contrast, the claimed invention pauses a video program in response to the detection of the audio communications.

Furthermore, the Herz reference and the Examiner's Official Notices do not bridge the substantial gap between the Abecassis reference and the Applicant's invention. Specifically, the Herz reference discloses

In addition to the news clipping service described above, the system for customized electronic identification of desirable objects functions in an e-mail environment in a similar but slightly different manner. The news clipping service selects and retrieves news information that would not otherwise reach its subscribers. But at the same time, large numbers of e-mail messages do reach users, having been generated and sent by humans or automatic programs. These

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users need an e-mail filter, which automatically processes the messages received. The necessary processing includes a determination of the action to be taken with each message, including, but not limited to: filing the message, notifying the user of receipt of a high priority message, automatically responding to a message. The e-mail filter system must not require too great an investment on the part of the user to learn and use, and the user must have confidence in the appropriateness of the actions automatically taken by the system. The same filter may be applied to voice mail messages or facsimile messages that have been converted into electronically stored text, whether automatically or at the user's request, via the use of well-known techniques for speech recognition or optical character recognition (see Herz, column 61, line 51 to column 62, line 6).

Thus, the Herz reference merely discloses that voice mail messages may be converted into electronically stored text via use of well-known techniques for speech recognition or optical character recognition. Nowhere in the Herz references is there any teaching or suggestion of "pausing the video program in response to the detection of the occurrence of the audio communication event."

Moreover, the Examiner has taken numerous Official Notices with respect to the dependent claims. For example, the Examiner has taken Official Notice that "associating text and graphics with a telephone number is well-known in the art." However, none of the Examiner's Official Notices teach or suggest "pausing the video program in response to the detection of the occurrence of the audio communications events."

Even if the references and the Examiner's Official Notices could somehow be operably combined, the combination would merely provide a user of the system having to accept a communication during the use of the system, in response to the acceptance of such communication causing the video server transmission to be paused, converting voice mail messages into electronically stored text, and illustratively, associating text and graphics with a telephone number. The combined references are completely different from the Applicant's invention since the Applicant's invention pauses a video program in response to the detection of the audio communication's event, without having to perform an affirmative acceptance action.

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Therefore, since the combination of the Abecassis and Herz references, as well as the Examiner's Official Notices, fails to teach or suggest the improvements and features of the Applicant's invention, the combined references fail to teach or suggest Applicant's invention as a whole. As such, Applicant submits that independent claims 1, 29, and 57, as well as dependent claims 2-21, 30-49, and 58-77, which depend directly or indirectly from independent claims 1, 29, and 57 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

C. Claims 27-28, 55-56, and 83-84

Applicant's independent claim 27 (and similarly, independent claims 55 and 83) recites:

"27. A method for audio-to-text conversion of real-time telephone calls during viewing of a video program, comprising:
receiving a video program;
outputting the video program for presentation on a display device;
detecting occurrence of an incoming telephone call;
detecting an off-hook condition indicating answering of the telephone call;
converting an audio portion of the telephone call to corresponding text; and
displaying the corresponding text with the video program."
(emphasis added).

The Abecassis reference discloses:

The content-on-demand architecture provides for an elegant integration of the video and communication services that can be delivered to a viewer by these and a variety of other communication systems. Specifically, while RAVIT 931 is retrieving a video from either a video services provider or from a storage device in RAVIT, RAVIT may receive a communication. The "communication" may be in the form of a conventional phone call, videophone call, fax, messaging and paging, and any analog or digital transmission (see Abecassis, column 51, lines 16-25).

Further, the Examiner states that Abecassis inherently detects an off-hook condition as Abecassis discloses that the phone calls may be incoming communications, and that if communications are accepted, the video is paused. Thus, Abecassis must be able to detect when a call is retrieved, and when a call has not been

retrieved, otherwise, the device would not know whether or not to pause the video. The Applicant's respectfully disagree with the Examiner's contention that Abecassis inherently detects an off-hook condition. Specifically, the detection of an incoming communication does not necessitate that the signaling for such communication be an "off-hook" condition. Rather, the signal that the system detects may be any of a number of types of signals capable of notifying the user of an incoming communication. For example, specific packetized information may be sent as a notification of incoming communications or a bit flag may be sent in a particular signal or message, among other techniques to notify the system and the user of an incoming communication. Therefore, the Abecassis reference does not inherently teach an off-hook condition.

Furthermore, the Herz reference does not bridge the substantial gap between the Abecassis reference and the Applicant's invention. Specifically, the Herz reference discloses:

In addition to the news clipping service described above, the system for customized electronic identification of desirable objects functions in an e/ mail [email] environment in a similar but slightly different manner. The news clipping service selects and retrieves news information that would not otherwise reach its subscribers. But at the same time, large numbers of e-mail messages do reach users, having been generated and sent by humans or automatic programs. These users need an e-mail filter, which automatically processes the messages received. The necessary processing includes a determination of the action to be taken with each message, including, but not limited to: filing the message, notifying the user of receipt of a high priority message, automatically responding to a message. The e-mail filter system must not require too great an investment on the part of the user to learn and use, and the user must have confidence in the appropriateness of the actions automatically taken by the system. The same filter may be applied to voice mail messages or facsimile messages that have been converted into electronically stored text, whether automatically or at the user's request, via the use of well-known techniques for speech recognition or optical character recognition (see Herz, column 61, line 51 to column 62, line 6).

Even if the two references could somehow be operably combined, the combination would merely disclose an acceptance procedure that is invoked in response to a received communication, wherein a user must affirm an acceptance of the received communication within a prescribed period of time, and converting voice

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mail messages into electronically stored text. Nowhere in the combined references is there any teaching or suggestion of "detecting an off-hook condition indicating answering of the telephone call."

Therefore, since the combination of the Abecassis and Herz references, as well as the Examiner's Official Notices, fails to teach or suggest the improvements and features of the Applicant's invention, the combined references fail to teach or suggest Applicant's invention as a whole. As such, Applicant submits that independent claims 27, 55, and 83, as well as dependent claims 28, 56, and 84, which respectively depend from independent claims 27, 55, and 83 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

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CONCLUSION

Thus, Applicant submits that all of the claims presently in the application are non-obvious under 35 U.S.C. §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 11/23/04



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